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09/332,459	06/14/1999	JUSTIN B. MAGARAM	1800	2958

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Law Offices of Albert S Michalik, PLLC
704-228th Avenue NE
Ste 193
Sammamish, WA 98074

EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/332,459

Applicant(s)
Magaram et al.

Examiner
Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 25, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-9, 11-29, and 31-37 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-29, and 31-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on September 25, 2002, which paper has been placed of record in the file.
2. Claims 2, 10, 30 are canceled. Claims 34-37 are added. Claims 1, 3-9, 11-29, and 31-37 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-14 have been considered but are not persuasive. In the arguments regarding to claims 1 and 21, applicant stated that, Bromley does not teach "the first and second objects having a defined hierarchical relationship", examiner totally disagrees. See column 20, lines 15-26, the retirement date (second object) is calculated based the date of birth (first object), thus the retirement date and the date of birth having a defined hierarchical relationship. Moreover, regarding to claims 12-14, Bromley also teaches disabling and/or enabling objects, see figure 14, item 224, figure 15, item 227, the box allow the user to select and/or deselect for disabling and/or enabling objects. Therefore, the examiner decides to maintain the rejection in the previous office action, add the rejection regarding to the added claims and make this action FINAL.
4. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 provides for the use of claim 18, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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7. Claim 36 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1, 3, 4, 7, 8, 11-14, 16, 18-20, 35, 36, 21-23, 26, 27, 29, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Bromley et al, U.S. Patent No. 5,819,263.

Regarding to claim 1, Bromley discloses a computer-readable medium having computer-executable instructions, comprising:

receiving input of a value corresponding to a first field of a plan element; receiving additional input corresponding to a second field of a plan element, the input defining the second

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field as having a value based on the first field; and developing a plan by running a simulation on plan elements including the first and second fields (column 20, lines 15-25).

receiving input of a new value for the first field, and developing a new plan by running a simulation on plan elements including the first and second fields wherein the new value changes the information in the second field (column 17, lines 25-30 and column 20, lines 15-25).

Regarding to claims 3-4, Bromley further discloses the plan is a financial plan and the first field represents a date and the second field represents a date based on the first field (column 20, lines 15-25).

Regarding to claims 7-8, Bromley further discloses the plan is a financial plan and wherein the first field represents a rate and the second field represents a date conditional on the rete represented in the first field (column 20, lines 9-14).

Regarding to claim 11, Bromley further discloses associating a plurality of objects in a package object (column 10, lines 17-60).

Regarding to claims 12-14, Bromley further discloses disabling at least one plan element, enabling at least one plan element, and developing a plan by running a simulation includes arranging a list of plan elements that includes enabled elements and excludes disabled elements are (see figures 14 and 15).

Regarding to claim 16, Bromley further discloses receiving input information includes providing a user interface (figure 8A).

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Claims 18-20, 35, 36 contain similar limitations founds in claims 1, 12-14, 16, discussed above, therefore, are rejected by the same rationale.

Claims 21-23, 26, 27, 29, 31, 32 contain similar limitations founds in claims 1, 3, 4, 7, 8, 12-14, discussed above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 6, 9, 15, 17, 24, 25, 28, 33, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bromley et al, U.S. Patent No. 5,819,263 in view of Official notice taken by Examiner.

[An alternative rejection on claims 1, 3, 4 as follow: it obvious and well-known in the art to obtain: a computer-readable medium having computer-executable instructions, comprising: receiving input of a value corresponding to a first field of a plan element; receiving additional input corresponding to a second field of a plan element, the input defining the second field as having a value based on the first field; and developing a plan by running a simulation on plan elements including the first and second fields. For example, a person in the skill of the art of computer science can write a short software program in C++ language to calculate the user's

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retirement date based on the user's birth date. The user enter his/her birth date and the program automatically calculating the user's retirement day. In the program, the first field is "user's birth date" and the second field is "user's retirement date = user's birth date + 65" (the retirement age is normally set to 65 years old). Moreover, the user can enter the new value for the first field such as his spouse's birth date, the program will automatically update his spouse's retirement date.]

Regarding to claims 5-6, Bromley disclose the plan is a financial plan but he does not teach the first field represents an amount the second field represents a date conditional on the amount represented in the first field. However, it obvious to write the program to automatically calculate the date conditional on the amount. For example, an employee started working at 1/1/2001 with the salary \$50,000, every year he will get promotion which increases 7% of his current salary, the person in the skill of the art can write a program to calculate the date when his salary hit to \$100,000. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Bromley's for the purpose of automatically calculate the date conditional on the amount.

Regarding to claim 9, receiving input corresponding to an adjustment value related to the second field is well-known in the art. For example, the retirement age can be adjusted to 60, so the second field "retirement date" becomes "birth date + 60".

Regarding to claim 15, Bromley does not teach developing a plan by running a simulation includes removing expired elements from the list. However, removing expired elements from the list is well-known in the art. Therefore, it would have been obvious to one

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with ordinary skill in the art at the time the invention was made to include the feature above with Bromley's for the purpose of deleting all of the expired when running a new plan.

Regarding to claims 17, 34, Bromley does not teach input information includes synchronizing plan elements with data from another program includes synchronizing only the plan elements that have been previously identified for synchronization. However, importing data from another program is old and well-known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Bromley's for the purpose of providing more information the user needs to establish a plan.

Claims 24, 25, 28, 33, 37 contain similar limitations founds in claims 5, 6, 9, 17, 34, discussed above, therefore, are rejected by the same rationale.

Conclusion

12. Claims **1, 3-9, 11-29, and 31-37** are rejected.

13. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Albright et al (US 6,012,043) discloses a computerized system and method used in financial planning.

Kiritz (US 5,991,745) discloses reverse mortgage loan calculation system and process.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh, can be reached on (703)308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.

15. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

(703) 305-7687, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

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Nga B. Nguyen
December 23, 2002



Hyung-Suk Sough
Primary Examiner